

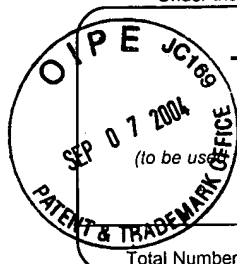
09-09-04

DAC
3738

PTO/SB/21 (04-04)

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U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

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**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

Application Number	10/039,066
Filing Date	January 4, 2002
First Named Inventor	John M. Shamoun
Art Unit	3738
Examiner Name	William H. Matthews
Attorney Docket Number	101108.0002US1

Total Number of Pages in This Submission

51

ENCLOSURES (Check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Copies of Office Actions of 1/21/04 & 7/26/04, responses thereto, postcards & Express Mail receipts (48 pages)
Remarks _____		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Martin Fessenmaier; Rutan & Tucker, LLP
Signature	
Date	09/07/04

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.	
Typed or printed name	Collene Houston
Signature	
Date	9/7/04

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 130.00

Complete if Known

Application Number 10/039,066
Filing Date January 4, 2002
First Named Inventor John M. Shamoun
Examiner Name William H. Matthews
Art Unit 3738
Attorney Docket No. 101108.0002US1

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

Deposit Account Number 502191
Deposit Account Name Rutan & Tucker, LLP

The Director is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☒ Credit any overpayments

☐ Charge any additional fee(s) or any underpayment of fee(s)

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1) (\$)					

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

		Extra Claims		Fee from below		Fee Paid
Total Claims	<input type="text"/>	-20** =	<input type="text"/>	X	<input type="text"/>	<input type="text"/>
Independent Claims	<input type="text"/>	-3** =	<input type="text"/>	X	<input type="text"/>	<input type="text"/>
Multiple Dependent					<input type="text"/>	<input type="text"/>

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	130.00
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 130.00

SUBMITTED BY

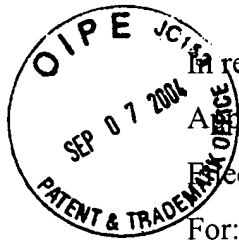
Name (Print/Type) Martin Fessenmaier Registration No. 46,697 Telephone 714-641-5100
Signature [Signature] (Attorney/Agent) Date 09/07/04

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS.
SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re application of: John M. Shamoun, Dr.

Application No.: 10/039,066

Filed: 01/04/2002

For: Cosmetic Surgery Preview System

Group No.: 3738

Examiner: William Matthews

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO WITHDRAW HOLDING OF ABANDONMENT

1. I hereby petition to withdraw the holding of abandonment in this case, on the basis that the United States Patent and Trademark Office has received more than one response in reply to the Office Action dated January 21, 2004, contrary to the statement on the Notice of Abandonment mailed on August 23, 2004.
2. I hereby state:
 - (a) A Response to the Final Office Action mailed January 21, 2004 was filed on May 18, 2004 along with a Petition for Extension of Time.
 - (b) In response to applicant's Response to the Final Office Action, the USPTO issued an Advisory Action on July 26, 2004.
 - (c) A Response to the Advisory Action was filed with a Request for Continued Examination (RCE) on August 20, 2004.
 - (d) The USPTO's own records indicate that items (a) – (c) above were in fact received and processed by the USPTO in connection with the USPTO's file for this application.

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10*

I hereby certify that, on the date shown below, this correspondence is being deposited with the United States Postal Service in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 as "Express Mail Post Office to Addressee" Mailing Label No. EV 607355486 US.

Date:


9/7/04
Colene Houston

3. Attached are copies of the referenced documents in items (a) – (c).
4. As additional evidence of non-receipt of the Office Action, I also attach a printout of PAIRS showing the transaction history for this application.
5. In consideration of these submissions, it is respectfully requested that the holding of abandonment be withdrawn.
6. The petition fee (37 C.F.R. § 1.17(h)–\$130.00) is paid as follows:

Authorization is hereby made to charge the amount of \$130.00 to Deposit Account No. 502191. Please charge any additional fees required by this paper or credit any overpayment in the manner authorized above.

Date: 09/07/04

Reg. No.: 46,697
Tel. No.: 714-641-5100
Customer No.: 34284

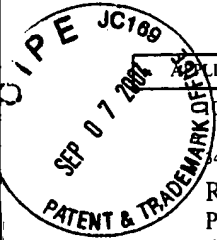


Signature of Practitioner
Martin Fessenmaier
Rutan & Tucker, LLP
P.O. Box 1950
611 Anton Blvd., 14th Floor
Costa Mesa, CA 92628-1950



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
0/039,066	01/04/2002	John M. Shamoun	12457-0002/JWE	9125

4284 7590 01/21/2004

ROBERT D. FISH; RUTAN & TUCKER, LLP
P.O. BOX 1950
611 ANTON BLVD., 14TH FLOOR
COSTA MESA, CA 92628-1950

101108.0002
EXAMINER

MATTHEWS, WILLIAM H

ART UNIT	PAPER NUMBER
3738	

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/039,066

Applicant(s)

SHAMOUN, JOHN M.

Examiner

William H. Matthews (Howie)

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If the period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

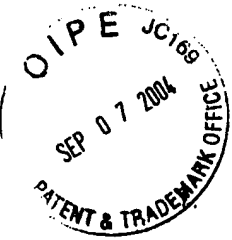
Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 3738



DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

1. Claims 11, 19, and 20 are objected to because of the following informalities described in the last office action:

Claim 11 should recite in subsection M), "yes" and "no" as answers. Subsections I) and N) contain answers that should begin on a new line.

In line 5 of claim 19, ---to--- should be inserted after "answers".

In line 5 of claim 20, "work" should be deleted.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Massengill US 2002/0064302 and in view of Broderick et al. US 2003/0007123 or Onyshkevych et al. US PN 6,665,577.

Massengill discloses in abstract, paragraphs [0026], [0030]-[0034],[0048], and [0051] a method of providing a preview image of a cosmetic surgery procedure for the nose or breasts comprising asking multiple choice questions (including measurements) and using the answers over a network to form the image.

With regard to the newly added limitation to independent claims 1, 19, and 20, Massengill lacks the express written disclosure of performing the method without using an image of the patient.

Broderick et al. discloses in paragraphs [0051], [0054]-[0056],[0058],[0060], and [0063]-[0065] a method of providing a preview image of a cosmetic procedure for the eyes comprising asking multiple choice questions and using the answers over a network to form the image from a database of pre-existing images for the patient to select from and modify.

Onyshkevych et al. discloses in lines 1-18 of col. 16, lines 60 of col. 19 through line 5 of col. 20, and lines 43-53 of col. 22 a method of providing internet based transactions, including cosmetic surgery, in which the user may answer qualitative and/or quantitative questions to produce a digitized image from a database or select a similar image from a database in order to serve users unwilling to provide an actual physical image.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method disclosed by Massengill by using images not from the patient as taught by either of Onyshkevych and Broderick et al. in order to serve patients unwilling to provide an actual physical image.

With specific regard to claim 13, Massengill lacks the express disclosure of asking for the specific breast measurements described in claim 13. However, in the art of cosmetic surgery, it would have been obvious, if not inherent, to ask for measurements of the patient's breasts in order to provide pre-operative and post-operative comparison for the patient when performing breast enhancement procedures.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method disclosed by Massengill by including the step of asking for specific breast measurements in order to provide pre-operative and post-operative comparison for the patient when performing breast enhancement procedures.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3738

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Matthews (Howie) whose telephone number is 703-305-0316. The examiner can normally be reached on Mon-Fri 7:00-4:30 (Every other Friday off).

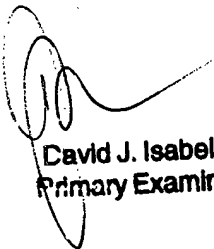
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine M. McDermott can be reached on 703-308-2111. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-2708 for regular communications and (703) 305-3590 for After Final communications.

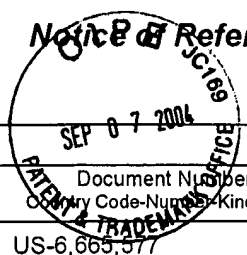
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

WHM

WHM

January 9, 2004


David J. Isabella
Primary Examiner

Notice of References Cited 	Application/Control No. 10/039,066	Applicant(s)/Patent Under Reexamination SHAMOUN, JOHN M.	
	Examiner William H. Matthews (Howie)	Art Unit 3738	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-6,665,577	12-2003	Onyshkevych et al.	700/130
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

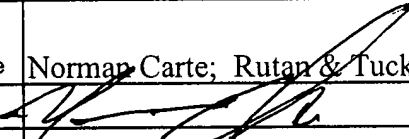
*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing) SEP 07 2004 PATENT & TRADEMARK OFFICE	Application Number	10/039,066	
	Filing Date	January 4, 2002	
	First Named Inventor	John M. Shamoun	
	Art Unit	3738	
	Examiner Name	William H. Matthews	
Total Number of Pages in This Submission	18	Attorney Docket Number	101108.0002US1


ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input checked="" type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input checked="" type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Norman Carte; Rutan & Tucker, LLP
Signature	
Date	May 18, 2004

CERTIFICATE OF TRANSMISSION/MAILING

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Typed or printed name	Collene Houston		
Signature		Date	05/18/2004

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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FEE TRANSMITTAL

SEP 07 2004

for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT**

(\$) 55.00

Complete if Known

Application Number	10/039,066
Filing Date	January 4, 2002
First Named Inventor	John M. Shamoun
Examiner Name	William H. Matthews
Art Unit	3738
Attorney Docket No.	101108.0002US1

METHOD OF PAYMENT (check all that apply)
☒ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None
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502191

Rutan & Tucker, LLP

The Director is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☒ Credit any overpayments☐ Charge any additional fee(s) or any underpayment of fee(s)☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) (\$)**2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE**

	Extra Claims	Fee from below	Fee Paid
Total Claims	-20** =	X	
Independent Claims	-3** =	X	
Multiple Dependent			

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1202	18	2202	9	Claims in excess of 20	
1201	86	2201	43	Independent claims in excess of 3	
1203	290	2203	145	Multiple dependent claim, if not paid	
1204	86	2204	43	** Reissue independent claims over original patent	
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent	

SUBTOTAL (2) (\$)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	55.00
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

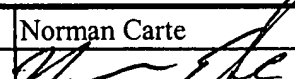
Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$)

55.00

SUBMITTED BY

Name (Print/Type)	Norman Carte	Registration No. (Attorney/Agent)	30,455	Telephone	714-641-5100
Signature		Date	May 18, 2004		

(Complete if applicable)

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PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a)

Docket Number (Optional) 101108.0002US1



In re Application of John M. Shamoun

Application Number 10/039,066

Filed January 4, 2002

For COSMETIC SURGERY PREVIEW SYSTEM

Art Unit 3738

Examiner William H. Matthews

This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above identified application.

The requested extension and appropriate non-small-entity fee are as follows (check time period desired):

- ☒ One month (37 CFR 1.17(a)(1)) \$ 110.00
- ☐ Two months (37 CFR 1.17(a)(2)) \$ _____
- ☐ Three months (37 CFR 1.17(a)(3)) \$ _____
- ☐ Four months (37 CFR 1.17(a)(4)) \$ _____
- ☐ Five months (37 CFR 1.17(a)(5)) \$ _____

☒ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee amount shown above is reduced by one-half, and the resulting fee is: \$ 55.00.

☒ A check in the amount of the fee is enclosed.

☐ Payment by credit card. Form PTO-2038 is attached.

☐ The Director has already been authorized to change fees in this application to a Deposit Account.

☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 502191.

I have enclosed a duplicate copy of this sheet.

I am the ☐ applicant/inventor.

☐ assignee of record of the entire interest. See 37 CFR 3.71.
Statement under 37 CFR 3.73(b) is enclosed (Form PTO/SB/96).

☒ attorney or agent of record. Registration Number 30,455

☐ attorney or agent under 37 CFR 1.34(a).
Registration number if acting under 37 CFR 1.34(a) _____

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May 18, 2004

Date

(714) 641-5100

Telephone Number

Signature

Norman Carte

Typed or printed name


NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☒ Total of 1 forms are submitted.

This collection of information is required by 37 CFR 1.136(a). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 6 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Applicant : Shamoun, John M.
Application No. : 10/039,066
Filed : 01/04/2002
Title : COSMETIC SURGERY PREVIEW SYSTEM
Group./Div. : 3738
Examiner : Matthews, William H.
Client Matter : 101108.0002US1
Customer No. : 34284

Commissioner for Patents
P.O. Box 1450
Washington, D.C. 20231

AMENDMENT AF

ART UNIT 3738

Dear Sir:

In response to the Final Office Action mailed January 21, 2004, please amend the above-identified patent application as follows:

Amendments to the Claims are reflected in the listing of claims, which begins on page 2 of this paper.

Remarks/Arguments begin on page 12 of this paper.

Amendments to the Claims:

This listing of claims will replace all prior listings.

Listing of Claims:

What is claimed is:

Claim 1 (currently amended) A method for providing a preview via a network of the potential effects of cosmetic surgery, the method comprising:

- selecting a cosmetic surgery procedure;
- asking at least one question regarding the body of a patient via the network;
- answering the question(s) via the network; and
- using the answers to form a preview image of the patient showing the potential effects of the selected cosmetic surgery procedure without using an image of the patient.

Claim 2 (previously presented) The method as recited in claim 1, wherein at least one image is provided in association with the question(s) so as to facilitate answering of the question(s).

Claim 3 (previously presented) The method as recited in claim 1, further comprising selecting at least one image which matches some characteristic of a patient.

Claim 4 (previously presented) The method as recited in claim 1, wherein selecting a cosmetic surgery procedure comprises selecting a cosmetic surgery category from the group consisting of:

- a cosmetic surgery procedure for the breasts;
- a cosmetic surgery procedure for the eyes;
- a cosmetic surgery procedure for the removal of fat;
- a cosmetic surgery procedure for the lips;
- a cosmetic surgery procedure for the ears;
- a cosmetic surgery procedure for the face;
- a cosmetic surgery procedure for the hair;
- a cosmetic surgery procedure for the mitigation of scar tissue;
- a cosmetic surgery procedure for the nose;
- a cosmetic surgery procedure for the chin; and

a cosmetic surgery procedure for the cheeks.

Claim 5 (previously presented) The method as recited in claim 4, wherein selecting a cosmetic surgery procedure comprises selecting a specific cosmetic surgery procedure.

Claim 6 (previously presented) The method as recited in claim 4, wherein selecting a cosmetic surgery procedure comprises selecting a specific cosmetic surgery procedure within the selected category.

Claim 7 (previously presented) The method as recited in claim 1, wherein selecting a cosmetic surgery procedure comprises selecting one of a plurality of different breast enhancement procedures.

Claim 8 (previously presented) The method as recited in claim 1, wherein asking at least one question comprises asking a plurality of questions about the present form, e.g., shapes, size, coloration, of body of the patient.

Claim 9 (previously presented) The method as recited in claim 1, wherein asking at least one question comprises asking at least one question about the history of the body of the patient.

Claim 10 (previously presented) The method as recited in claim 1, wherein asking at least one question comprises asking a plurality of multiple choice questions.

Claim 11 (currently amended) The method as recited in claim 1, wherein asking at least one question comprises asking at least some of the following questions having the following corresponding possible answers:

- A) How would you describe your breasts?
- I have never been pregnant and I have little, if any breast tissue;
- I have very nice, small or medium sized B cup breasts with essentially no droopiness;
- I have never been pregnant and have little or any breast tissue;
- I have very nice C cup breasts with excellent shape and symmetry;

I had B cup breasts prior to pregnancy; at the time of pregnancy, I went to a C or D, and now I have shrunken, small A—B cup breasts with missing volume and not much droopiness;

I had C cup breasts until childbirth, at which time they became D cups; now I have large B cup to C cup breasts which appear droopy;

B) Age?;

C) Weight and height?;

D) Breast size: A cup, B cup, C cup, or D cup?;

E) Do you have significant asymmetry? ;

Yes:

No:

F) My ancestral background is:

Asian;

Mid Eastern;

Afro—American;

American;

Hispanic;

G) My body type is:

Mesomorphic (muscular);

ectomorphic (very thin);

endomorphc (large boned);

H) I would describe my chest wall (if I cut my body in half and looked at it on cross-section) as:

barrel chest;

thin pencil chest;

normal cylinder;

abnormal because it is sunken in at the middle;

abnormal because it protrudes in the middle;

I) I would describe my breast tissue as:

dense (hard to the touch);

fatty (very soft to the touch);

mixed;

J) I would describe my breast shape as:

round;

tubular;

flat with no existing breast tissue, or breast tissue only at the level of the nipple or above, with no breast tissue below the nipple;

perfect teardrop;

K) I would describe my skin as:

stretchy with stretch marks;

very droopy;

thick, virgin type skin with excellent pliability;

L) I have had more than one pregnancy and have breast feed more than one child:

yes;

no;

M) My weight with the exception of pregnancy was within 10-20 lbs. of normal;

yes;

no;

- N) I would describe my areolae as:
dilated;
stretched and enlarged;
normal dimensions;
normal diameter, very small diameter (less than 3.5 cm);
- O) I would describe the pigment of my areola as:
darkly pigmented;
lightly pigmented;
- P) I would describe my nipple projection as:
large;
normal;
inverted;
- Q) Preexisting history of breast cancer in:
sister;
maternal relative;
one relative, two relatives, greater than two relatives;
- R) I prefer:
a very natural look to my breasts, (conservative);
for relatives or friends to not notice much of an enlargement in clothing; however,
when wearing skimpy clothes or a bathing suit, more noticeable image changes are apparent;
- S) In addition, I desire:
a very natural appearing breast when nude;
an obvious difference in clothing as well as nude and in all clothing wear;
a very fake looking breast with headlight appearance and round, full volume (very
unnatural look nude); and
obvious breast implant look.

Claim 12 (previously presented) The method as recited in claim 1, wherein asking at least one question comprises asking for a plurality of measurement results.

Claim 13 (previously presented) The method as recited in claim 1, wherein asking at least one question comprises asking for the following measurement results:

sternal notch to nipple distance;
bilateral inframammary crease to nipple distance;
nipple to nipple distance; and
bilateral base dimension.

Claim 14 (previously presented) The method as recited in claim 1, wherein asking at least one question comprises asking a plurality of multiple choice questions and asking for a plurality of measurement results.

Claim 15 (currently amended) The method as recited in claim 1, wherein using the answers to ~~from~~ form a preview image of the patient showing the potential effects of the selected cosmetic surgery procedure comprises using the answers to form a preview image of the affected body part.

Claim 16 (currently amended) The method as recited in claim 1, wherein using the answers to ~~from~~ form a preview image of the patient showing the potential effects of the selected cosmetic surgery procedure comprises selecting a pre-existing image which most closely matches a predicted outcome of the cosmetic surgery procedure.

Claim 17 (currently amended) The method as recited in claim 1, wherein using the answers to ~~from~~ form a preview image of the patient showing the potential effects of the selected cosmetic surgery procedure comprises generating a new image which most closely matches a predicted outcome of the cosmetic surgery procedure.

Claim 18 (currently amended) A method for showing potential results of a breast enhancement cosmetic surgery procedure via the Internet without requiring a picture of the prospective patient, the method comprising:

selecting a breast enhancement cosmetic surgery procedure to be performed; asking at least some of the following questions having the following corresponding possible answers:

- A) How would you describe your breasts?
- I have never been pregnant and I have little, if any breast tissue;
- I have very nice, small or medium sized B cup breasts with essentially no droopiness;
- I have been pregnant and have little or any breast tissue;
- I have very nice C cup breasts with excellent shape and symmetry;
- I had B cup breasts prior to pregnancy; at the time of pregnancy, I went to a C or D, and now I have shrunken, small A—B cup breasts with missing volume and not much droopiness;
- I had C cup breasts until childbirth, at which time they became D cups; now I have large B cup to C cup breasts which appear droopy;

B) Age?

C) Weight and height?

D) Breast size: A cup, B cup, C cup, or D cup?;

E) I Do you have significant asymmetry ?;

Yes;

No;

- F) My ancestral background is:
Asian;
Mid Eastern;
Afro—American;
American;
Hispanic;
- G) My body type is:
Mesomorphic (muscular);
ectomorphic (very thin);
endomorph (large boned);
- H) I would describe my chest wall (if I cut my body in half and looked at it on cross—section) as:
barrel chest;
thin pencil chest;
normal cylinder;
abnormal because it is sunken in at the middle;
abnormal because it protrudes in the middle;
- I) I would describe my breast tissue as:
dense (hard to the touch);
fatty (very soft to the touch)
mixed;
- J) I would describe my breast shape as:
round;
tubular;
flat with no existing breast tissue, or breast tissue only at the level of the nipple or above, with no breast tissue below the nipple;
perfect teardrop;
- K) I would describe my skin as:

stretchy with stretch marks;

very droopy;

thick, virgin type skin with excellent pliability;

L) I have had more than one pregnancy and have breast feed more than one child:

yes;

no;

M) My weight with the exception of pregnancy was within 10—20 lbs. of normal;

yes;

no

N) I would describe my areolae as:

dilated;

stretched and enlarged;

normal dimensions;

normal diameter, very small diameter (less than 3.5 cm);

O) I would describe the pigment of my areola as:

darkly pigmented;

lightly pigmented;

P) I would describe my nipple projection as:

large;

normal;

inverted;

Q) Preexisting history of breast cancer in:

sister;

maternal relative;

one relative, two relatives, greater than two relatives;

R) I prefer:

a very natural look to my breasts, (conservative);
for relatives or friends to not notice much of an enlargement in clothing; however,
when wearing skimpy clothes or a bathing suit, more noticeable image changes are apparent;

S) In addition, I desire:
a very natural appearing breast when nude;
an obvious difference in clothing as well as nude and in all clothing wear;
a very fake looking breast with headlight appearance and round, full volume (very
unnatural look nude); and
obvious breast implant look.

Claim 19 (currently amended) A method for providing a preview via a network of
the potential effects of cosmetic surgery, the method comprising:
providing a selection of cosmetic surgery procedures;
asking at least one question regarding the body of a patient via the network;
receiving answers to the question(s) via the network; and
using the answers to form a preview image of the patient showing the potential
effects of the selected cosmetic surgery procedure without using an image of the patient.

Claim 20 (currently amended) A method for providing a preview via a network of
the potential effects of cosmetic surgery, the method comprising:
selecting a cosmetic surgery procedure;
asking at least one question regarding the body of a patient via the network;
selecting at least one image which matches an anatomical characteristic of a
patient via the network; and
using the selected image(s) to form a preview image of the patient showing the
potential effects of the selected cosmetic surgery procedure without using an image of the
patient.

REMARKS

This is a response to the final Office Action mailed January 21, 2004, in relation to the above-identified patent application. Claims 1-20 are presently pending. Claims 11, 19, and 20 have been amended by this response.

In the Office Action, the Examiner objected to claims 11, 19, and 20 based upon matters of formality. The claims have been amended accordingly.

The Examiner also rejected claims 1-20 under 35 U.S.C. 103(a) as being unpatentable over Massengill, in view of Broderick or Onyshkevych. In this rejection, the Examiner stated that "Massengill lacks the express written disclosure of performing the method without using an image of the patent." Thus, the Examiner is apparently relying upon either Broderick or Onyshkevych to cure the deficiencies of Massengill alone to make the claimed invention obvious.

The Examiner states that Broderick discloses "a method of providing a preview image of a cosmetic procedure for the eyes comprising asking multiple choice questions and using the answers over a network to form the image from a database of pre-existing images for the patent to select from and modify."

However, it is important to appreciate that a "cosmetic procedure" is not a cosmetic surgery procedure. Some of the important differences between a cosmetic procedure and a cosmetic surgery procedure include the techniques used (cutting or otherwise modifying tissue versus painting or otherwise changing the color or appearance of the skin); cost (surgery is much more expensive than the application of cosmetics); results (surgery tends to be permanent, whereas the application of cosmetics tends to be temporary); and reversibility (surgery tends to be difficult to reverse, whereas cosmetics can be easily removed).

Moreover, surgery and cosmetics tend to be practiced by different groups of people. Surgeons are highly trained, well educated, medical doctors. Cosmeticians are sales people.

disclosure for use in a rejection under 35 U.S.C. 103, the disclosure must be sufficiently enabling so as to make the claimed subject matter obvious.

It is respectfully submitted that the material of Onyshkevych is so different from that of the present invention (garment fitting and sizing versus cosmetic surgery) that one would not look to Onyshkevych to solve cosmetic surgery problems in the first place, but even if one did, it certainly is not obvious that the teachings of Onyshkevych with respect to garment fitting and sizing can be applied to cosmetic surgery.

Onyshkevych completely lacks any teaching as to how its fitting and sizing techniques can be applied to cosmetic surgery, and thus does not qualify as a proper reference under 35 U.S.C. 103. It is not even clear that the fitting and sizing techniques of the Onyshkevych reference can actually be applied to cosmetic surgery.

Indeed, even if the fitting and sizing techniques can, in some fashion, be applied to cosmetic surgery, it is important to appreciate that these techniques tend to be inherently gross in their very nature. That is, the information needed for the fitting and sizing of garments is inherently less detailed than the information needed for the cosmetic surgery procedures of the present invention.

Cosmetic surgery is thus one of many applications in a long list of possibilities, without any specific disclosure of how the techniques described with respect to garment fitting may be applied to cosmetic surgery.

Further, the Onyshkevych reference is believed to constitute non-analogous art with respect to the Massengill reference. One looking to solve problems associated with cosmetic surgery simply would not look to garment fitting art for solutions. Thus, there is no motivation to combine the Onyshkevych reference with the Massengill reference.

It is further respectfully submitted that none of the cited prior art addresses the particular problems associated with breast enhancement cosmetic surgery or addresses any of the solutions to these problems addressed by the claimed subject matter.

In view of the foregoing, it is respectfully submitted that none of the cited references, taken either alone or in combination with one another, either disclose or make obvious “selecting a cosmetic surgery procedure; asking at least one question regarding the body of a patient via the network; answering the question(s) via the network; and using the answers to form a preview image of the patent showing the potential effects of the selected cosmetic surgery procedure without using an image of the patient,” as recited in independent claim 1.

It is further respectfully submitted that none of the cited references, taken either alone or in combination with one another, either disclose or make obvious “selecting a breast enhancement cosmetic surgery procedure” and asking the specific questions of independent claim 18.

It is further respectfully submitted that the dependent claims are independently patentable with respect to the independent claims. None of the cited references either disclose or make obvious the detail of the limitations of the dependent claims. For example, none of the cited references either disclose or make obvious the questions relating to breast surgery of dependent claim 11.

Applicant respectfully request that the Examiner withdraw the holding of finality because the Examiner cited new prior art for new grounds of rejection in this Office Action.

Applicant respectfully submits that all of the claims of the subject patent application are in condition for immediate allowance. Application respectfully requests reconsideration and an early allowance.

Respectfully submitted,
Rutan & Tucker, LLP

By: _____
Norman E. Carte
Registration No. 30,455

Rutan & Tucker, LLP611 Anton Blvd., Suite 1400
Costa Mesa, CA 92626

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Totals:		\$55.00

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Title:	Cosmetic Surgery Preview System
Inventor:	Shamoun - John Shamoun, M.D.
Filing Date:	04 January 2002
Serial Number:	10/039066
Matter Type:	Patent - US
Date of Deposit:	18 May 2004
Matter #:	101108.0002US1
Enclosures:	(A) Transmittal Form; (B) Fee Transmittal; (C) Petition for 1 Month Extension of Time; (D) Amendment AF (Response to Final Office Action) (15 pages); (E) Check No. 3020690 for \$55.00; and (G) Return Receipt Postcard.

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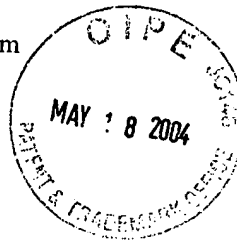
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Title:	Cosmetic Surgery Preview System
Inventor:	Shamoun - John Shamoun, M.D.
Filing Date:	04 January 2002
Serial Number:	10/039066
Matter Type:	Patent - US
Date of Deposit:	18 May 2004
Matter #:	101108.0002US1
Enclosures:	(A) Transmittal Form; (B) Fee Transmittal; (C) Petition for 1 Month Extension of Time; (D) Amendment AF (Response to Final Office Action) (15 pages); (E) Check No. 3020690 for \$55.00; and (G) Return Receipt Postcard.





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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,066	01/04/2002	John M. Shamoun	12457-0002/JWE	9125
34284	7590	07/26/2004	082516-0004/US	
ROBERT D. FISH; RUTAN & TUCKER, LLP P.O. BOX 1950 611 ANTON BLVD., 14TH FLOOR COSTA MESA, CA 92628-1950			EXAMINER MATTHEWS, WILLIAM H	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 07/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/039,066

Applicant(s)

SHAMOUN, JOHN M.

Examiner

William H. Matthews (Howie)

Art Unit

3738

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: "without using an image of the patient".

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

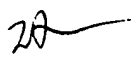
Claim(s) objected to: _____.

Claim(s) rejected: 1-20.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.


CORRINE McDERMOTT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700


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Request For Continued Examination (RCE) Transmittal

Address to:
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Application Number	10/039,066
Filing Date	January 4, 2002
First Named Inventor	John M. Shamoun
Art Unit	3738
Examiner Name	William H. Matthews
Attorney Docket Number	101108.0002US1

This is a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application.

Request for Continued Examination (RCE) practice under 37 CFR 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. See Instruction Sheet for RCEs (not to be submitted to the USPTO) on page 2.

1. **Submission required under 37 CFR 1.114** Note: If the RCE is proper, any previously filed unentered amendments and amendments enclosed with the RCE will be entered in the order in which they were filed unless applicant instructs otherwise. If applicant does not wish to have any previously filed unentered amendment(s) entered, applicant must request non-entry of such amendment(s).

a. ☒ Previously submitted. If a final Office action is outstanding, any amendments filed after the final Office action may be considered as a submission even if this box is not checked.

i. ☒ Consider the arguments in the Appeal Brief or Rely Brief previously filed on May 18, 2004

ii. ☐ Other _____

b. ☐ Enclosed

i. ☐ Amendment/Reply

iii. ☐ Information Disclosure Statement (IDS)

ii. ☐ Affidavit(s)/ Declaration(s)

iv. ☐ Other _____

2. Miscellaneous

a. ☐ Suspension of action on the above-identified application is requested under 37 CFR 1.103(c) for a period of _____ months. (Period of suspension shall not exceed 3 months; Fee under 37 CFR 1.17(i) required)

b. ☐ Other _____

3. Fees

The RCE fee under 37 CFR 1.17(e) is required by 37 CFR 1.114 when the RCE is filed.

The Director is hereby authorized to charge the following fees, or credit any overpayments, to

a. ☒ Deposit Account No. 502191

i. ☒ RCE fee required under 37 CFR 1.17(e)

ii. ☒ Extension of time fee (37 CFR 1.136 and 1.17)

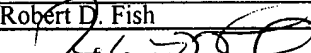
iii. ☐ Other _____

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Name (Print/Type)	Robert D. Fish	Registration No. (Attorney/Agent)	33,880
Signature		Date	8/20/04

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8/20/04

This collection of information is required by 37 CFR 1.114. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Shamoun, John M.
Application No. : 10/039,066
Filed : 01/04/2002
Title : COSMETIC SURGERY PREVIEW SYSTEM
Group./Div. : 3738
Examiner : Matthews, William H.
Client Matter : 101108.0002US1
Customer No. : 34284

Commissioner for Patents
P.O. Box 1450
Washington, D.C. 20231

AMENDMENT AF

ART UNIT 3738

Dear Sir:

In response to the Final Office Action mailed January 21, 2004, please amend the above-identified patent application as follows:

Amendments to the Claims are reflected in the listing of claims, which begins on page 2 of this paper.

Remarks/Arguments begin on page 12 of this paper.

Amendments to the Claims:

This listing of claims will replace all prior listings.

Listing of Claims:

What is claimed is:

Claim 1 (currently amended) A method for providing a preview via a network of the potential effects of cosmetic surgery, the method comprising:

- selecting a cosmetic surgery procedure;
- asking at least one question regarding the body of a patient via the network;
- answering the question(s) via the network; and
- using the answers to form a preview image of the patient showing the potential effects of the selected cosmetic surgery procedure without using an image of the patient.

Claim 2 (previously presented) The method as recited in claim 1, wherein at least one image is provided in association with the question(s) so as to facilitate answering of the question(s).

Claim 3 (previously presented) The method as recited in claim 1, further comprising selecting at least one image which matches some characteristic of a patient.

Claim 4 (previously presented) The method as recited in claim 1, wherein selecting a cosmetic surgery procedure comprises selecting a cosmetic surgery category from the group consisting of:

- a cosmetic surgery procedure for the breasts;
- a cosmetic surgery procedure for the eyes;
- a cosmetic surgery procedure for the removal of fat;
- a cosmetic surgery procedure for the lips;
- a cosmetic surgery procedure for the ears;
- a cosmetic surgery procedure for the face;
- a cosmetic surgery procedure for the hair;
- a cosmetic surgery procedure for the mitigation of scar tissue;
- a cosmetic surgery procedure for the nose;
- a cosmetic surgery procedure for the chin; and

a cosmetic surgery procedure for the cheeks.

Claim 5 (previously presented) The method as recited in claim 4, wherein selecting a cosmetic surgery procedure comprises selecting a specific cosmetic surgery procedure.

Claim 6 (previously presented) The method as recited in claim 4, wherein selecting a cosmetic surgery procedure comprises selecting a specific cosmetic surgery procedure within the selected category.

Claim 7 (previously presented) The method as recited in claim 1, wherein selecting a cosmetic surgery procedure comprises selecting one of a plurality of different breast enhancement procedures.

Claim 8 (previously presented) The method as recited in claim 1, wherein asking at least one question comprises asking a plurality of questions about the present form, e.g., shapes, size, coloration, of body of the patient.

Claim 9 (previously presented) The method as recited in claim 1, wherein asking at least one question comprises asking at least one question about the history of the body of the patient.

Claim 10 (previously presented) The method as recited in claim 1, wherein asking at least one question comprises asking a plurality of multiple choice questions.

Claim 11 (currently amended) The method as recited in claim 1, wherein asking at least one question comprises asking at least some of the following questions having the following corresponding possible answers:

- A) How would you describe your breasts?
- I have never been pregnant and I have little, if any breast tissue;
- I have very nice, small or medium sized B cup breasts with essentially no droopiness;
- I have never been pregnant and have little or any breast tissue;
- I have very nice C cup breasts with excellent shape and symmetry;

I had B cup breasts prior to pregnancy; at the time of pregnancy, I went to a C or D, and now I have shrunken, small A—B cup breasts with missing volume and not much droopiness;

I had C cup breasts until childbirth, at which time they became D cups; now I have large B cup to C cup breasts which appear droopy;

- B) Age?;
- C) Weight and height?;
- D) Breast size: A cup, B cup, C cup, or D cup?;
- E) I Do you have significant asymmetry? ;

Yes:

No:

- F) My ancestral background is:
 - Asian;
 - Mid Eastern;
 - Afro—American;
 - American;
 - Hispanic;
- G) My body type is:
 - Mesomorphic (muscular);
 - ectomorphic (very thin);
 - endomorphie (large boned);
- H) I would describe my chest wall (if I cut my body in half and looked at it on cross-section) as:
 - barrel chest;
 - thin pencil chest;
 - normal cylinder;

abnormal because it is sunken in at the middle;
abnormal because it protrudes in the middle;

I) I would describe my breast tissue as:

dense (hard to the touch);
fatty (very soft to the touch);
mixed;

J) I would describe my breast shape as:

round;
tubular;

flat with no existing breast tissue, or breast tissue only at the level of the nipple or
above, with no breast tissue below the nipple;
perfect teardrop;

K) I would describe my skin as:

stretchy with stretch marks;
very droopy;
thick, virgin type skin with excellent pliability;

L) I have had more than one pregnancy and have breast feed more than one child:

yes;
no;

M) My weight with the exception of pregnancy was within 10-20 lbs. of normal;

yes;
no;

N) I would describe my areolae as:

dilated;

stretched and enlarged;

normal dimensions;

normal diameter, very small diameter (less than 3.5 cm);

O) I would describe the pigment of my areola as:

darkly pigmented;

lightly pigmented;

P) I would describe my nipple projection as:

large;

normal;

inverted;

Q) Preexisting history of breast cancer in:

sister;

maternal relative;

one relative, two relatives, greater than two relatives;

R) I prefer:

a very natural look to my breasts, (conservative);

for relatives or friends to not notice much of an enlargement in clothing; however,
when wearing skimpy clothes or a bathing suit, more noticeable image changes are apparent;

S) In addition, I desire:

a very natural appearing breast when nude;

an obvious difference in clothing as well as nude and in all clothing wear;

a very fake looking breast with headlight appearance and round, full volume (very
unnatural look nude); and

obvious breast implant look.

Claim 12 (previously presented) The method as recited in claim 1, wherein asking at least one question comprises asking for a plurality of measurement results.

Claim 13 (previously presented) The method as recited in claim 1, wherein asking at least one question comprises asking for the following measurement results:

sternal notch to nipple distance;
bilateral inframammary crease to nipple distance;
nipple to nipple distance; and
bilateral base dimension.

Claim 14 (previously presented) The method as recited in claim 1, wherein asking at least one question comprises asking a plurality of multiple choice questions and asking for a plurality of measurement results.

Claim 15 (currently amended) The method as recited in claim 1, wherein using the answers to ~~from~~ form a preview image of the patient showing the potential effects of the selected cosmetic surgery procedure comprises using the answers to form a preview image of the affected body part.

Claim 16 (currently amended) The method as recited in claim 1, wherein using the answers to ~~from~~ form a preview image of the patient showing the potential effects of the selected cosmetic surgery procedure comprises selecting a pre-existing image which most closely matches a predicted outcome of the cosmetic surgery procedure.

Claim 17 (currently amended) The method as recited in claim 1, wherein using the answers to ~~from~~ form a preview image of the patient showing the potential effects of the selected cosmetic surgery procedure comprises generating a new image which most closely matches a predicted outcome of the cosmetic surgery procedure.

Claim 18 (currently amended) A method for showing potential results of a breast enhancement cosmetic surgery procedure via the Internet without requiring a picture of the prospective patient, the method comprising:

selecting a breast enhancement cosmetic surgery procedure to be performed; asking at least some of the following questions having the following corresponding possible answers:

A) How would you describe your breasts?

I have never been pregnant and I have little, if any breast tissue;

I have very nice, small or medium sized B cup breasts with essentially no droopiness;

I have been pregnant and have little or any breast tissue;

I have very nice C cup breasts with excellent shape and symmetry;

I had B cup breasts prior to pregnancy; at the time of pregnancy, I went to a C or D, and now I have shrunken, small A—B cup breasts with missing volume and not much droopiness;

I had C cup breasts until childbirth, at which time they became D cups; now I have large B cup to C cup breasts which appear droopy;

B) Age?

C) Weight and height?

D) Breast size: A cup, B cup, C cup, or D cup?;

E) I Do you have significant asymmetry ?;

Yes;

No;

- F) My ancestral background is:
Asian;
Mid Eastern;
Afro—American;
American;
Hispanic;
- G) My body type is:
Mesomorphic (muscular);
ectomorphic (very thin);
endomorphie (large boned);
- H) I would describe my chest wall (if I cut my body in half and looked at it on cross—section) as:
barrel chest;
thin pencil chest;
normal cylinder;
abnormal because it is sunken in at the middle;
abnormal because it protrudes in the middle;
- I) I would describe my breast tissue as:
dense (hard to the touch);
fatty (very soft to the touch)
mixed;
- J) I would describe my breast shape as:
round;
tubular;
flat with no existing breast tissue, or breast tissue only at the level of the nipple or above, with no breast tissue below the nipple;
perfect teardrop;
- K) I would describe my skin as:

a very natural look to my breasts, (conservative);
for relatives or friends to not notice much of an enlargement in clothing; however,
when wearing skimpy clothes or a bathing suit, more noticeable image changes are apparent;

S) In addition, I desire:
a very natural appearing breast when nude;
an obvious difference in clothing as well as nude and in all clothing wear;
a very fake looking breast with headlight appearance and round, full volume (very
unnatural look nude); and
obvious breast implant look.

Claim 19 (currently amended) A method for providing a preview via a network of
the potential effects of cosmetic surgery, the method comprising:
providing a selection of cosmetic surgery procedures;
asking at least one question regarding the body of a patient via the network;
receiving answers to the question(s) via the network; and
using the answers to form a preview image of the patient showing the potential
effects of the selected cosmetic surgery procedure without using an image of the patient.

Claim 20 (currently amended) A method for providing a preview via a network of
the potential effects of cosmetic surgery, the method comprising:
selecting a cosmetic surgery procedure;
asking at least one question regarding the body of a patient via the network;
selecting at least one image which matches an anatomical characteristic of a
patient via the network; and
using the selected image(s) to form a preview image of the patient showing the
potential effects of the selected cosmetic surgery procedure without using an image of the
patient.

REMARKS

This is a response to the final Office Action mailed January 21, 2004, in relation to the above-identified patent application. Claims 1-20 are presently pending. Claims 11, 19, and 20 have been amended by this response.

In the Office Action, the Examiner objected to claims 11, 19, and 20 based upon matters of formality. The claims have been amended accordingly.

The Examiner also rejected claims 1-20 under 35 U.S.C. 103(a) as being unpatentable over Massengill, in view of Broderick or Onyshkevych. In this rejection, the Examiner stated that "Massengill lacks the express written disclosure of performing the method without using an image of the patent." Thus, the Examiner is apparently relying upon either Broderick or Onyshkevych to cure the deficiencies of Massengill alone to make the claimed invention obvious.

The Examiner states that Broderick discloses "a method of providing a preview image of a cosmetic procedure for the eyes comprising asking multiple choice questions and using the answers over a network to form the image from a database of pre-existing images for the patent to select from and modify."

However, it is important to appreciate that a "cosmetic procedure" is not a cosmetic surgery procedure. Some of the important differences between a cosmetic procedure and a cosmetic surgery procedure include the techniques used (cutting or otherwise modifying tissue versus painting or otherwise changing the color or appearance of the skin); cost (surgery is much more expensive than the application of cosmetics); results (surgery tends to be permanent, whereas the application of cosmetics tends to be temporary); and reversibility (surgery tends to be difficult to reverse, whereas cosmetics can be easily removed).

Moreover, surgery and cosmetics tend to be practiced by different groups of people. Surgeons are highly trained, well educated, medical doctors. Cosmeticians are sales people.

disclosure for use in a rejection under 35 U.S.C. 103, the disclosure must be sufficiently enabling so as to make the claimed subject matter obvious.

It is respectfully submitted that the material of Onyshkevych is so different from that of the present invention (garment fitting and sizing versus cosmetic surgery) that one would not look to Onyshkevych to solve cosmetic surgery problems in the first place, but even if one did, it certainly is not obvious that the teachings of Onyshkevych with respect to garment fitting and sizing can be applied to cosmetic surgery.

Onyshkevych completely lacks any teaching as to how its fitting and sizing techniques can be applied to cosmetic surgery, and thus does not qualify as a proper reference under 35 U.S.C. 103. It is not even clear that the fitting and sizing techniques of the Onyshkevych reference can actually be applied to cosmetic surgery.

Indeed, even if the fitting and sizing techniques can, in some fashion, be applied to cosmetic surgery, it is important to appreciate that these techniques tend to be inherently gross in their very nature. That is, the information needed for the fitting and sizing of garments is inherently less detailed than the information needed for the cosmetic surgery procedures of the present invention.

Cosmetic surgery is thus one of many applications in a long list of possibilities, without any specific disclosure of how the techniques described with respect to garment fitting may be applied to cosmetic surgery.

Further, the Onyshkevych reference is believed to constitute non-analogous art with respect to the Massengill reference. One looking to solve problems associated with cosmetic surgery simply would not look to garment fitting art for solutions. Thus, there is no motivation to combine the Onyshkevych reference with the Massengill reference.

It is further respectfully submitted that none of the cited prior art addresses the particular problems associated with breast enhancement cosmetic surgery or addresses any of the solutions to these problems addressed by the claimed subject matter.

In view of the foregoing, it is respectfully submitted that none of the cited references, taken either alone or in combination with one another, either disclose or make obvious “selecting a cosmetic surgery procedure”; asking at least one question regarding the body of a patient via the network; answering the question(s) via the network; and using the answers to form a preview image of the patent showing the potential effects of the selected cosmetic surgery procedure without using an image of the patient,” as recited in independent claim 1.

It is further respectfully submitted that none of the cited references, taken either alone or in combination with one another, either disclose or make obvious “selecting a breast enhancement cosmetic surgery procedure” and asking the specific questions of independent claim 18.

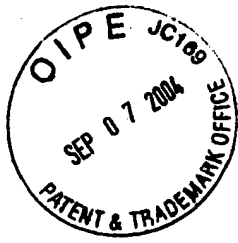
It is further respectfully submitted that the dependent claims are independently patentable with respect to the independent claims. None of the cited references either disclose or make obvious the detail of the limitations of the dependent claims. For example, none of the cited references either disclose or make obvious the questions relating to breast surgery of dependent claim 11.

Applicant respectfully request that the Examiner withdraw the holding of finality because the Examiner cited new prior art for new grounds of rejection in this Office Action.

Applicant respectfully submits that all of the claims of the subject patent application are in condition for immediate allowance. Application respectfully requests reconsideration and an early allowance.

Respectfully submitted,
Rutan & Tucker, LLP

By: _____
Norman E. Carte
Registration No. 30,455



Please acknowledge receipt of the following by affixing hereon the Official date stamp and returning this card to our office.

Title:	Cosmetic Surgery Preview System
Inventor:	Shamoun - John Shamoun, M.D.
Filing Date:	04 January 2002
Serial Number:	10/039066
Matter Type:	Patent - US
Date of Deposit:	18 May 2004
Matter #:	101108.0002US1
Enclosures:	(A) Request for Continued Examination (RCE) Transmittal; (B) Copy of Amendment AF (Response to Final Office Action) filed May 18, 2004 (15 pages); and (C) Return Receipt Postcard.

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